

PROSKAUER ROSE LLP

One International Place
14th Floor
Boston, MA 02110-2600
Telephone 617.526.9800
Fax 617.526.9899

NEW YORK
LOS ANGELES
WASHINGTON
BOCA RATON
NEWARK
NEW ORLEANS
PARIS

RECEIVED
CENTRAL FAX CENTER

NOV 08 2004

Fax Transmittal

Date November 8, 2004 Client-Matter 49548-032

Total Pages (Including Cover) **13**

From Joseph A. Capraro, Jr.

Sender's Voice Number 617.526.9800

Sender's Room Number BN

Sender's Email Address jcapraro@proskauer.com

Main Fax Number 617.526.9899

To: Examiner Mark Paschall

Fax No.: 703.872.9306

Company: US Patent and Trademark Office

Voice No.: 703.308.1642

Message

Re: U.S. Patent Application Serial No.: 09/774,165

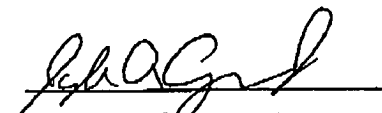
Attorney Docket No. ASX-015CP

Examiner Paschall,

Regarding my voicemail of November 3, 2004, attached are copies of the Form PTO-1449, associated transmittal papers, and the Return Receipt postcard that we submitted to the USPTO on January 9, 2004 for U.S. Patent Application Serial No. 09/774,165. The Return Receipt postcard was stamped on January 12, 2004 by the USPTO, acknowledging receipt of the Form PTO-1449 and related papers.

At your earliest convenience, please initial the references listed in the Form PTO-1449 and return the initialed form to us via return facsimile. Please let me know if you would like us to provide you with new copies of the documents listed in the Form PTO-1449.

Thank you for your assistant in this matter.


Joseph A. Capraro, Jr.
Reg. No. 36,471
Phone: 617.526.9800
Fax: 617.526.9899

Confidentiality Note: This message is confidential and intended only for the use of the addressee(s) named above. It may contain legally privileged material. Dissemination, distribution or copying of this message, other than by such addressee(s), is strictly prohibited. If you have received this message in error, please immediately notify us by telephone and return the original to us at the address above. We will reimburse you for the cost of the telephone call and postage. Thank you.

6730/49548-032 BNLB1/7425v1

ASX-0

The "RECEIVED" stamp of the Patent Office indicates that the Applicant has acknowledged the filing

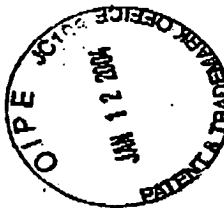
Transmittal Form (1 page); Fee Transmittal (1 page); Supplemental Information Disclosures Statement (3 pages); Form PTO-1449 (3 pages); References Labeled A76 to A123, B6 a C122 to C125; Check in the Amount of \$180.00; and a Certificate of First Class Mailing Dated January 9, 2004 (1 page).

Applicants: Chen et al.

Serial Number: 09/774,165

Atty: Joseph A. Capraro, Jr./om

Date: January 9, 2004



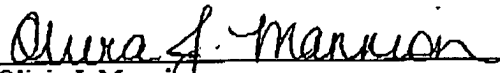
PATENT
Attorney Docket No. ASX-015CP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S): Chen et al.
SERIAL NO.: 09/774,165 GROUP NO.: 3742
FILING DATE: Janaury 26, 2001 EXAMINER: M. Paschall
TITLE: INTEGRATED PLASMA CHAMBER AND INDUCTIVELY-
COUPLED TOROIDAL PLASMA SOURCE

CERTIFICATE OF FIRST CLASS MAILING UNDER 37 C.F.R. 1.8

I hereby certify that this correspondence, and any document(s) referred to as enclosed herein, is/are being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 9th day of January, 2004.


Olivia J. Mannion

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450


Sir:

Submitted herewith are: Transmittal Form (1 page); Fee Transmittal (1 page);
Supplemental Information Disclosure Statement (3 pages); Form PTO-1449 (3 pages);
References Labeled A76 to A123, B6 and C122 to C125; Check in the Amount of \$180; and a
return receipt postcard.

2729569-1

TRANSMITTAL FORM	Application Serial Number		09/774,165
	Filing Date		January 26, 2001
	First Named Inventor		Chen
	Group Art Unit		3742
	Examiner Name		M. Paschall
	Attorney Docket No.		ASX-015CP
	Patent No.		Not applicable
	Issue Date		Not applicable

ENCLOSURES (check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Check Attached <input type="checkbox"/> Copy of Fee Transmittal Form <input type="checkbox"/> Amendment/Response <input type="checkbox"/> Preliminary <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Letter to Official Draftsperson including Drawings (Total Sheets <u> </u>) <input type="checkbox"/> Petition for Extension of Time <input checked="" type="checkbox"/> Supplemental Information Disclosure Statement <input checked="" type="checkbox"/> Form PTO-1449 <input checked="" type="checkbox"/> Copies of IDS Citations <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Sequence Listing submission <input type="checkbox"/> Paper Copy/CD <input type="checkbox"/> Computer Readable Copy <input type="checkbox"/> Statement verifying identity of above	<input type="checkbox"/> Copy of Notice to File Missing Parts of Application <input type="checkbox"/> Formal Drawing(s) <input type="checkbox"/> Request For Continued Examination (RCE) Transmittal <input type="checkbox"/> Power of Attorney (Revocation of Prior Powers) <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Executed Declaration and Power of Attorney for Utility or Design Patent Application <input type="checkbox"/> Small Entity Statement <input type="checkbox"/> CD(s) for large table or computer program <input type="checkbox"/> Amendment After Allowance <input type="checkbox"/> Request for Certificate of Correction <input type="checkbox"/> Certificate of Correction (in duplicate)	<input type="checkbox"/> Notice of Appeal to Board of Patent Appeals and Interferences <input type="checkbox"/> Appeal Brief (in triplicate) <input type="checkbox"/> Status Inquiry <input checked="" type="checkbox"/> Return Receipt Postcard <input checked="" type="checkbox"/> Certificate of First Class Mailing under 37 C.F.R. 1.8 <input type="checkbox"/> Certificate of Facsimile Transmission under 37 C.F.R. 1.8 <input type="checkbox"/> Additional Enclosure(s) (please identify below)

CORRESPONDENCE ADDRESS	SIGNATURE BLOCK
Direct all correspondence to: Patent Administrator Testa, Hurwitz & Thibault, LLP High Street Tower 125 High Street Boston, MA 02110 Tel. No.: (617) 248-7000 Fax No.: (617) 248-7100	Respectfully submitted,  Joseph A. Caputo, Jr. Attorney for the Applicants Testa, Hurwitz & Thibault, LLP High Street Tower 125 High Street Boston, MA 02110 Date: January 9, 2004 Reg. No. 36,471 Tel. No.: (617) 248-7369 Fax No.: (617) 248-7100

VER 12/00
2729582-1

FEE TRANSMITTAL

FY 2004

Complete if Known

Application Serial Number 09/774,165
 Filing Date January 26, 2001
 First Named Inventor Chen
 Group Art Unit 3742
 Examiner Name M. Paschall
 Attorney Docket No. ASX-015CP

METHOD OF PAYMENT

1. ☒ Payment Enclosed:
☒ Check ☐ Money Order ☐ Other
2. ☒ The Commissioner is hereby authorized to credit or charge any fee indicated below for this submission to Deposit Account No. 20-0531.
☐ Required Fees (copy of this sheet enclosed).
☒ Additional fee required under 37 CFR 1.16 and 1.17.
☒ Overpayment Credit.
3. ☐ Applicant claims small entity status.

FEE CALCULATION

1. FILING FEE

Large Entity Fee (\$)	Fee Description	Fee Paid
770	Utility filing fee	
340	Design filing fee	
160	Provisional filing fee	

Number Filed	Number Extra	Rate	Amount
--------------	--------------	------	--------

Total Claims - 20 = x \$ 18.00 =

Independent Claims - 3 = x \$ 86.00 =

☐ Multiple Dependent Claim(s), if any \$290.00 =

TOTAL:

SMALL ENTITY DISCOUNT:

SUBTOTAL (1) (\$) 0.00

2. AMENDMENT CLAIM FEES

Claims Remaining After Amend.	Highest No. Previously Paid For	Present Extra	Rate	Fee Paid
-------------------------------	---------------------------------	---------------	------	----------

Total = x \$ 18.00 =

Indep. = x \$ 86.00 =

☐ First Presentation of Multiple Dep. Claim + \$290.00 =

TOTAL: (\$)

SMALL ENTITY DISCOUNT: (\$)

SUBTOTAL (2) (\$) 0.00

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Fee (\$)	Small Entity Fee (\$)	Fee Description	Fee Paid
130	65	Surcharge - late filing fee or oath	
50	25	Surcharge - late provisional filing fee or cover sheet	
130	130	Non-English specification	
2,520	2,520	Request for ex parte reexamination	
110	55	Extension for reply within first month	
420	210	Extension for reply within second month	
950	475	Extension for reply within third month	
1480	740	Extension for reply within fourth month	
2010	1005	Extension for reply within fifth month	
330	165	Notice of Appeal	
330	165	Filing a brief in support of an appeal	
290	145	Request for oral hearing	
130	130	Petitions to the Commissioner	
180	180	Submission of Information Disclosure Statement	180.00
770	385	Filing a submission after final rejection (37 CFR 1.129(a))	
770	385	For each additional invention to be examined (37 CFR 1.129(b))	
100	100	Certificate of Correction for applicant's error	
110	55	Submission of Terminal Disclaimer	

Other fee (Specify)

Other fee (Specify)

SUBTOTAL (3) (\$) 180.00

SUBTOTAL (1) 0.00

SUBTOTAL (2) 180.00

SUBTOTAL (3) 0.00

TOTAL (\$) 180.00

CORRESPONDENCE ADDRESS

Direct all correspondence to:

Patent Administrator
 Testa, Hurwitz & Thibault, LLP
 High Street Tower-125 High Street
 Boston, MA 02110
 Tel. No.: (617) 248-7000
 Fax No.: (617) 248-7100

SIGNATURE BLOCK

Date: January 9, 2004
 Reg. No.: 36,471
 Tel. No.: (617) 248-7369
 Fax No.: (617) 248-7100

Respectfully submitted,

Joseph A. Caputo, Jr.
 Joseph A. Caputo, Jr.
 Attorney for the Applicants
 Testa, Hurwitz & Thibault, LLP
 High Street Tower-125 High Street
 Boston, MA 02110

2729577-1

PATENT **RECEIVED**
 Attorney Docket No. ASX-015 **CENTRAL FAX CENTER**
 NOV 08 2004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S): Chen et al.
 SERIAL NO.: 09/774,165 GROUP NO.: 3742
 FILING DATE: Janaury 26, 2001 EXAMINER: M. Paschall
 TITLE: INTEGRATED PLASMA CHAMBER AND INDUCTIVELY-
 COUPLED TOROIDAL PLASMA SOURCE

Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Sir:

In accordance with the provisions of 37 C.F.R. 1.97 and 1.98, Applicants hereby make of record the patents and publications listed on the accompanying Form PTO-1449, and other information contained herein, for consideration by the Examiner in connection with the examination of the above-identified patent application. Copies of the patents and publications are enclosed.

REMARKS

In accordance with the provisions of 37 C.F.R. 1.97, this statement is being filed (CHECK ONE):

- ☐ (1) within three (3) months of the filing date of a national application other than a continued prosecution application under 37 C.F.R. 1.53(d), or within three (3) months of the date of entry of the national stage as set forth in 37 C.F.R. 1.491 in an international application, or before the mailing of the first Office action on the merits, or before the mailing of a first Office action after the filing of a request for continued examination under 37 C.F.R. 1.114; or
- ☒ (2) after the period defined in (1) but before the mailing date of a final action or a notice of allowance under 37 C.F.R. 1.311, and
- ☐ the requisite Statement is below, OR
- ☒ the requisite fee under 37 C.F.R. 1.17(p), namely \$180.00, is included herein, or

Supplemental Information Disclosure Statement
Serial No. 09/774,165
Page 2

- ☐ (3) after the mailing date of a final action or notice of allowance but before the payment of the issue fee, AND
- ☐ the requisite Statement is below, AND
- ☐ the requisite petition fee under 37 C.F.R. 1.17(p), namely \$180.00 is included herein.

It is respectfully requested that each of the patents and publications listed on the attached Form PTO-1449, and other information contained herein, be made of record in this application.

STATEMENT

As required under 37 C.F.R. 1.97(e), Applicant(s), through the undersigned, hereby state either that [check the appropriate space only if either (2) or (3) is checked on the previous page and the Statement is required]:

- ☐ 1. Each item of information contained in the Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the Information Disclosure Statement; or
- ☐ 2. No item of information contained in the Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing this Statement after making reasonable inquiry, no item of information contained in the Information Disclosure Statement was known to any individual designated in 37 C.F.R. 1.56(c) more than three months prior to the filing of the Information Disclosure Statement.

On April 3, 2003, Advanced Energy Industries, Inc. ("Advanced Energy") filed a Complaint in the United States District Court, District of Colorado (Civil Action No. 03-WM-0573 (CBS)) seeking a Declaratory Judgment that certain of its reactive gas sources do not infringe three patents owned by MKS Instruments, Inc.'s ("MKS's") subsidiary Applied Science and Technology, Inc. ("ASTeX"). The patents at issue in the Colorado lawsuit include U.S. Patent 6,150,628, U.S. Patent No. 6,338,226, and U.S. Patent No. 6,486,431. The subject application is a continuation-in-part of US Serial No. 09/774,165, which is a continuation-in-part of US Patent No. 6,486,431, which is a continuation of U.S. Patent 6,150,628. On May 14, 2003, MKS moved to dismiss or transfer the Colorado lawsuit.

On May 14, 2003, MKS and its subsidiary ASTeX filed a Complaint in United States District Court, District of Delaware (Civil Action No. 03-469-JJF) alleging that Advanced Energy was infringing

Supplemental Information Disclosure Statement
Serial No. 09/774,165
Page 3

five patents owned by ASTeX by making, offering for sale and selling certain reactive gas sources. The patents at issue in the Delaware lawsuit include the patents at issue in the Colorado lawsuit, U.S. Patent 6,552,296, and U.S. Patent No. 6,559,408. On July 10, 2003, Advanced Energy moved to dismiss or transfer the Delaware lawsuit. On December 24, 2003, the Colorado Court ordered the lawsuit transferred to the United States Court, District of Delaware. A Markman Hearing in the Delaware lawsuit is scheduled for January 13, 2004, and a jury trial is scheduled for late July 2004. Discovery is proceeding on a schedule set by the United States District Court, District of Delaware.

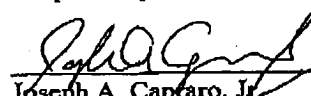
Applicants' enclose copies of the complaint and amended complaint in the (now transferred) Colorado lawsuit and copies of the complaint and answer in the Delaware lawsuit. In its amended complaint in the Colorado lawsuit and its answer in the Delaware lawsuit, AE alleges that one or more claims of the '628, '226, '431, '296, and '408 patents are invalid. See, e.g. pg. 9 of the amended complaint in the Colorado lawsuit (C125) and pg. 5 of the answer in the Delaware lawsuit (C124). As the Defendant in the Delaware lawsuit, Advanced Energy, has brought the patents and publications listed on the attached Form PTO-1449 to Applicants' attention during the discovery process.

In its amended complaint in the Colorado lawsuit and its answer in the Delaware lawsuit, Advanced Energy alleges, among other things, that one or more of the '226, '431, '296 and '408 patents are invalid, void and/or unenforceable due to inequitable conduct with intent to deceive in the form of failing to disclose material information, making material misrepresentations of fact, or submitting false material information to the PTO during prosecution of the applications that became the '226, '431, '296 and '408 patents. See, e.g., pp. 4-8 of the amended complaint in the Colorado lawsuit (C125) and pp. 6-11 of the answer in the Delaware lawsuit (C124).

Applicants' believe that the above-described allegations are without merit and expect to be fully vindicated through the judicial process. In accordance with their duty of candor and good faith, Applicants submit the enclosed documents for consideration.

If the Examiner has questions regarding any of the above, the Examiner is invited to call the undersigned attorney at (617) 248-7369.

Respectfully submitted,


Joseph A. Capraro, Jr.
Attorney for the Applicants
Testa, Hurwitz, & Thibault, LLP
High Street Tower
125 High Street
Boston, Massachusetts 02110

Date: January 9, 2004
Reg. No. 36,471

Tel. No.: (617) 248-7369
Fax No.: (617) 248-7100

2729562-1

SHEET 1 OF 3

FORM PTO - 1449 SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT				ATTORNEY DOCKET NO.: ASX-015CP APPLICANTS: Chen et al. SERIAL NO.: 09/774,165 FILING DATE: January 26, 2001 GROUP: 3742			
U.S. PATENT DOCUMENTS							
EXAM. INIT.	DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	FILING DATE IF APPROPRIATE	
	A76	H268	Owen				
	A77	3,054,742	Thonemann et al.				
	A78	3,109,801	Thonemann				
	A79	3,278,384	Lenard et al.				
	A80	3,433,705	Cornish				
	A81	4,057,462	Jassby et al.				
	A82	4,073,680	Kelley				
	A83	4,110,595	Brambilla et al.				
	A84	4,263,096	Ohkawa et al.				
	A85	4,282,267	Kilyel				
	A86	4,292,125	Bers				
	A87	4,368,092	Steinberg et al.				
	A88	4,431,898	Reinberg et al.				
	A89	4,601,871	Turner				
	A90	4,679,007	Reese et al.				
	A91	4,732,761	Machida et al.				
	A92	4,735,765	Harris et al.				
	A93	4,767,590	Stix et al.				
	A94	4,780,803	Dede Garcia-Santamaria				
	A95	4,794,217	Quan et al.				
	A96	4,861,622	Yamazaki et al.				
	A97	4,863,671	Okada				
EXAMINER				DATE CONSIDERED			

SHEET 2 OF 3

FORM PTO - 1449				ATTORNEY DOCKET NO.: ASX-015CP			
SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT				APPLICANTS: Chen et al.			
				SERIAL NO.: 09/774,165			
				FILING DATE: January 26, 2001		GROUP: 3742	
U.S. PATENT DOCUMENTS							
EXAM. INIT.		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	FILING DATE IF APPROPRIATE
	A98	4,877,757	10/31/89	York et al.			
	A99	4,908,492	03/13/90	Okamoto et al.			
	A100	4,918,031	04/17/90	Flamm et al.			
	A101	4,983,113	01/15/91	Fujimoto et al.			
	A102	4,996,077	02/26/91	Moslehi et al.			
	A103	5,061,838	10/29/91	Lane et al.			
	A104	5,130,003	07/14/92	Conrad			
	A105	5,187,454	02/16/93	Collins et al.			
	A106	5,303,139	04/12/94	Mark			
	A107	5,440,206	08/08/95	Kurono et al.			
	A108	5,460,689	10/24/95	Raaijmakers et al.			
	A109	5,505,780	04/09/96	Dalvie et al.			
	A110	5,565,247	10/15/96	Suzuki			
	A111	5,576,629	11/19/96	Turner et al.			
	A112	5,630,880	05/20/97	Eastlund			
	A113	5,654,679	08/05/97	Mavretic et al.			
	A114	5,712,592	01/27/98	Stimson et al.			
	A115	5,747,935	05/05/98	Porter et al.			
	A116	5,756,400	05/26/98	Ye et al.			
	A117	5,773,919	06/30/98	Seward			
	A118	5,811,022	09/22/98	Savas et al.			
	A119	5,939,886	08/17/99	Turner et al.			
	A120	5,998,933	12/07/99	Shun'ko			
EXAMINER				DATE CONSIDERED			

SHEET 3 OF 3

FORM PTO - 1449				ATTORNEY DOCKET NO.: ASX-015CP					
SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT				APPLICANT(S): Chen et al.					
				SERIAL NO.: 09/774,165					
				FILING DATE: January 26, 2001		GROUP: 3742			
U.S. PATENT DOCUMENTS									
EXAM. INIT.		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	FILING DATE IF APPROPRIATE		
	A121	6,007,879	12/28/99	Scholl					
	A122	6,164,241	12/26/00	Chen et al.					
	A123	6,253,704	07/03/01	Savas			9/17/99		
FOREIGN PATENT DOCUMENTS									
EXAM. INIT.		DOCUMENT NUMBER	DATE	COUNTRY CODE	CLASS	SUB CLASS	FILING DATE	ABSTRACT ONLY	ENGLISH LANG (Y/N)
	B6	61-1024	01/07/86	JP			06/12/84	N	Original and translation provided by Advanced Energy Industries, Inc. during litigation with Assignee
OTHER ART, JOURNAL ARTICLES, ETC.									
EXAM. INIT.	OTHER DOCUMENTS: (Including Author, Title, Date, Relevant Pages, Place of Publication)								
	C122	Complaint for Declaratory Judgment of Non-Infringement, filed in the United States District Court for the District of Colorado, by Advanced Energy Industries, Inc., dated April 3, 2003.							
	C123	Complaint, filed in the United States District Court for the District of Delaware, by MKS Instruments, Inc. and Applied Science and Technology, Inc., dated May 14, 2003							
	C124	Answer, filed in the United States District Court for the District of Delaware, by Advanced Energy Industries, Inc., dated December 10, 2003.							
	C125	Amended Complaint and Jury Demand, filed in the United States District Court for the District of Colorado, by Advanced Energy Industries, Inc., dated December 15, 2003.							
EXAMINER					DATE CONSIDERED				

2729535-1

Testa, Hurwitz & Thibault, LLP
125 High Street
Boston, MA 02110

Fleet Bank, N.A.
Boston, Massachusetts 02110

5-38/110

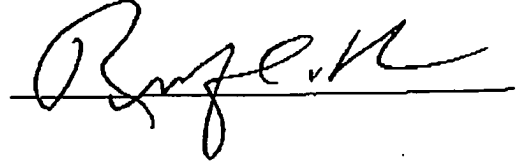
Date: January 8, 2004

Pay: One hundred eighty and 00/100 ***** \$ ***180.00***

PAY
TO THE
ORDER OF: Director of U.S. Patent & Trademark Office

Serial No. 09/774,165
Atty Docket No.: ASX-015CP

Testa, Hurwitz & Thibault, LLP



SECURITY FEATURES INCLUDED. DETAILS ON BACK.

⑈ 227567 ⑈ ⑆ 0110003901512 ⑈ 38317 ⑈

Payee: Director of U.S. Patent & Trademark Office
Vendor ID: DIREUS

Check #: 227567
Check Date: 01/08/2004

Invoice Num	Invoice Date	Reference	Invoice Amount	Discount Taken	Amount Paid
101209	01/08/2004		180.00	0.00	180.00
Totals:			\$180.00	\$0.00	\$180.00

ASX-015CP

The "RECEIVED" stamp of the Patent Office imprinted hereon acknowledges the filing of:

Transmittal Form (1 page); Fee Transmittal (1 page); Supplemental Information Disclosure Statement (3 pages); Form PTO-1449 (3 pages); References Labeled A76 to A123, B6 and C122 to C125; Check in the Amount of \$180.00; and a Certificate of First Class Mailing Dated January 9, 2004 (1 page).

Applicants: Chen et al.
Serial Number: 09/774,165
Atty: Joseph A. Capraro, Jr./om
Date: January 9, 2004

2729584-1